

PATENT

MS155614.01/MSFTP135US

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being transmitted via facsimile on the date shown below to:
(703) 872-9306, Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

3-8-05
Date:

[Signature]
Himanshu S. Amin

RECEIVED
CENTRAL FAX CENTER

MAR 08 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Curtis G. Wong, *et al.*

Examiner: Annan Q. Shang

Serial No: 09/650,481

Art Unit: 2614

Filing Date: August 29, 2000

Title: SYSTEM AND METHOD FOR IDENTIFYING AUDIO/VISUAL PROGRAMS TO
BE RECORDED

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

Applicants' representative submits this Reply Brief in response to the Examiner's Answer dated January 27, 2005. A Request for Oral Hearing and a credit card payment form are filed concurrently herewith, wherein the credit card payment form is believed to cover all fees due regarding this document and the Request for Oral Hearing. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP135US].

03/09/2005 BBONNER 00000024 09650481

01 FC:1402

500.00 OP

02 FC:1403

1000.00 OP

09/650,481

MS155614.01/MSFTP135US

REMARKS

Claims 1-26 are currently pending and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein. In particular, the following comments address deficiencies contended in the Examiner's Answer to applicants' Appeal Brief.

I. Regarding the Rejection of Claims 1-4, 7-9, 13, 16, 18-19, 20-23, and 25-26 Under 35 U.S.C. §102(e)

The Examiner incorrectly maintains the rejection of claims 1-4, 7-9, 13, 16, 18-19, 20-23, and 25-26 under 35 U.S.C. §102(e) as being anticipated by Hirata (U.S. 6,374,406). It is respectfully submitted that the assertions brought forth by the Examiner in the Final Office Action and the Examiner's Answer are incorrect in view of at least the reasons set forth below as well as in applicants' Appeal Brief.

Anticipation requires that the *identical* invention be disclosed, either expressly or inherently, in a single reference. (*See e.g., Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); and *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983)).

All of the subject claims recite the limitation a *token having a schema*. The token schema is defined in the subject application as a data structure that contains a plurality of fields for holding different types of data. (*See e.g., Application at p. 30, lines 27-30; Fig. 8; and Table 1*). In contrast, Hirata discloses an e-mail containing a control command character string for programming a video deck. (*See e.g., Hirata at col. 1, lines 49-62; and col. 6, lines 21-25*).

The Examiner has taken the position that the email of Hirata is a data structure identical to the token having a schema recited in the subject claims. (*See Examiner's Answer at pp. 7-8*). However, the Examiner ignores that the dependent claims recite the limitations that the token is operatively associated with or attached to an email. (*See dependent claims 2-3, 17*). Under the doctrine of claim differentiation and, as evidenced by dependent claims 2, 3, and 17, a token having a schema is not an email, but rather is a data structure that may be operatively associated

09/650,481

MS155614.01/MSFTP135US

with or attached to an email. Thus, an email containing a control command character string, as disclosed in Hirata, is not structurally *identical* to a token having a schema, which, although capable of being operatively associated with or attached to an email, is not an email.

In view of at least the reasons stated in the Appeal Brief and in this Reply Brief, the prior art does not disclose the *identical* invention as recited in the subject claims. In particular, a *token having a schema* is not disclosed, either expressly or inherently, in Hirata. Therefore, the rejection of independent claims 1, 8, 16, 20, and 22, and the claims that depend there from, should be withdrawn.

II. Regarding the Rejection of Claims 5-6, 10-12, 14-15, 17 and 24 Under 35 U.S.C. §103(a)

The Examiner incorrectly maintains the rejection of claims 5-6, 10-12, 14-15, 17 and 24 under 35 U.S.C. §103(a) as being obvious over Hirata. It is respectfully submitted that the assertions brought forth by the Examiner in the Final Office Action and the Examiner's Answer are incorrect in view of at least the reasons set forth below as well as in applicants' Appeal Brief. Claims 5-6, 10-12, 14-15, 17 and 24 all depend from one of the independent claims and, by virtue of this dependency, contain all of the limitations of the independent claims. All of the independent claims are allowable for at least the reasons stated in the Appeal Brief and in Section I *supra* – Hirata does not disclose a *token having a schema* as recited in the subject claims. Accordingly, these claims are allowable for at least the same reasons. Hence, this rejection should be withdrawn.

III. Regarding the Incorrect Statements in the Examiner's Answer

The Examiner contends that the Appeal Brief as filed did not contain a statement identifying the related appeals and interferences or a statement grouping the claims. Applicants' representative respectfully notes that a statement identifying the related appeals and interferences was provided in Section II of the Appeal Brief. (See Appeal Brief at p. 2). As to the grouping of the claims, applicants' representative respectfully notes that the rule requiring such a grouping, 37 C.F.R. §1.192(c)(7), is no longer in effect. (See 69 Fed. Reg. 49,959 (Aug. 12, 2004) (removing and reserving 37 C.F.R. §1.192 effective Sept. 13, 2004)). Applicants'

09/650,481

MS155614.01/MSFTP135US

representative submits that the Appeal Brief as filed complies with the rule currently in effect, 37 C.F.R. §41.37(c)(1)(vii).

IV. Conclusion

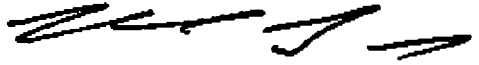
The subject application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP135US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731